

## REMARKS

The last Office Action of April 7, 2004 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-20 are pending in the application. Claims 1, 8, 9 and 18-20 have been amended. No claims have been canceled or added. An amendment to the specification has been made. No fee is due.

It is noted that the drawings are objected to because of some informalities. A drawing proposal showing the required changes are submitted herewith together with a communication to the draftsman.

It is noted that the specification is objected to because of some informalities. The specification has been amended, as suggested by the Examiner.

It is noted that claim 1 is objected to because of the use of the term "calotte". Claim 1 as well as claims 8 and 9 have been amended to replace the term "calotte" with --cup-- to relate to the curved annular surface configuration.

Claims 18-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No.5,116,933 to Newton.

Claims 18-20 stand also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No.6,191,204 to Johnson.

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,741,361 to in view of German Offenlegungsschrift DE 199 49 909 A1 to Dittmer.

Claims 1-20 stand also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Pat. No. 6,684,997 to Klopfer et al.

Claims 1-20 stand also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Pat. Appl. No. 10/103,909 to Klopfer et al. Note that this patent application has matured into U.S. Patent 6,719,117 on April 13, 2004.

#### **REJECTION OF CLAIMS 18-20 UNDER 35 U.S.C. §102(b)**

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

The present invention, as set forth in claim 18, is directed to a sliding element made of thermoplastic material in a clutch release bearing for disposition between a steel adjustment ring and a steel bearing ring. Applicant has amended claim 18 to more clearly set forth the essential feature of the present invention, and more particularly the positional relationship between the sliding element and the involved components of the clutch release bearing between which the sliding element is sandwiched. It is applicant's contention that the Examiner's intent to completely divorce this positional relationship from the remainder of the claim is ill-advised. Applicant's intention is not to protect any sliding element that is made

of thermoplastic material but only a sliding element of thermoplastic material situated between two steel components of a clutch release bearing, namely a steel adjustment ring and a steel bearing ring.

Neither the Newton nor Johnson relate in any way to a clutch release bearing, let alone to the disposition of a sliding element of thermoplastic material between two a steel adjustment ring and a steel bearing ring.

Withdrawal of the rejection of claims 18-20 under 35 U.S.C. §102(b) is thus respectfully requested.

#### **REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. §103(a)**

Applicant respectfully disagrees with the Examiner's rejection of claims 1-20 for the following reasons:

The present invention, as set forth in claim 1, is directed to a self-adjusting clutch release bearing having a sliding element of thermoplastic material disposed in a contact zone between an adjustment ring and a bearing ring to enhance the wear-resistance of the contact zone and to have low friction between moving parts. There are thus three distinct components that interact with one another (adjustment ring, bearing ring, sliding element).

Brandenstein describes a clutch release bearing having an inner ring with a curved outer face to abut against a correspondingly curved face of a clutch release disk (15). In this way, any gyrating movement of the clutch can be absorbed and compensated. In Brandenstein, the disk and the inner ring abut

one another directly and there is no reference whatsoever in Brandenstein as to the problem addressed by the present invention with respect to wear and friction. In fact, Brandenstein appears to teach away from the present invention when disposing an elastomeric sealing ring (18) away from the contact zone in an area between overlapping spaced-apart components of the inner ring and the disk. Brandenstein does not relate to any wear or friction issues in the contact zone.

The Examiner readily admits that Brandenstein fails to disclose a sliding element of thermoplastic material. In order to bridge the absence of such a sliding element, the Examiner combines Brandenstein with Dittmer which describes the provision of a plastic adjustment ring which abuts against an inner ring of a clutch release bearing. It is applicant's contention that a combination of Brandenstein and Dittmer fails to produce the subject matter, as set forth in claims 1 and 18. Dittmer, like Brandenstein, merely describes the curved configuration between directly abutting adjustment ring and bearing ring, whereby Dittmer discloses to make the adjustment ring of plastic. Neither Dittmer nor Brandenstein focuses in any way on the configuration of the contact zone by **adding** a further plastic component to reduce wear and to decrease friction between the adjustment ring and the bearing ring.

It is applicant's contention that a person skilled in the art would also not combine the references, as suggested by the Examiner, because, as already noted above, Brandenstein appears to teach away from the present invention by placing a plastic sealing ring at a distance to the contact zone. Thus,

Brandenstein never contemplated to add another part between the adjustment ring and the bearing ring, as taught by the present invention.

For the reasons set forth above, it is applicant's contention that neither Brandenstein nor Dittmer, nor a combination thereof teaches or suggests the features of the present invention, as recited in claims 1 and 18.

As for the rejection of the retained dependent claims, these claims depend on claims 1 and 18, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection of claims 1-20 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

#### **REJECTION OF CLAIMS 1-20 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING**

Applicant submits herewith a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) to overcome this rejection.

Withdrawal of the rejection of claims 1-20 under the judicially created doctrine of obviousness-type double patenting is thus respectfully requested.

#### **CITED REFERENCES**

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no

specific discussion thereof is necessary.

## **PRIORITY DOCUMENT**

On page 2 of the Office Action, the Examiner noted that no certified copy of priority document no. 101 24 663.3 is in the application file. The certified copy of the priority document has been ordered and will be submitted as soon as available.

## **CONCLUSION**

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses the provision of a separate sliding element in a contact zone between an adjustment ring and a bearing ring of a clutch release bearing.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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